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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,205	03/27/2001	Thomas H. Barrett JR.	11899.0250.NPUS00	2492

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EXAMINER

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/818,205	BARRETT ET AL.	
	Examiner	Art Unit	
	John S. Brusca	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 July 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudolph et al. in view of Slezak et al. in view of Peden et al. in view of Mikami et al.

The claims are drawn to a method of collecting time course data from an array of containers by entry of a user input to a database display of the matrix. In some embodiments the containers comprise cells, some data is assigned a default value, the data is entered manually by use of pull down menus, the database uses rules to process data inputs and to begin or end data collection. In some embodiments the claims are drawn to computer programs that execute the method or computers that execute the method.

Rudolph et al. shows in the abstract and throughout a method of repeatedly assaying rat cortical neuronal cell cultures in multiwell plates for NMDA toxicity. Viability is determined by fluorescence of propidium iodide which cannot enter viable cells but causes fluorescence in dead cells. Rudolph et al. shows that the multiwell plate was read by a CytoFluor 2300 scanner on page 149. A variety of control measurements were run including background fluorescence without cells, and maximum fluorescence from digitonin killed cells at the end of the time course. Examples of results are shown in figures 2 and 3. Rudolph et al. shows rules such as assigning total fluorescence to digitonin killed cells, reading values at 0 time point and stopping reading at 24 hours. Rudolph et al. does not show use of a database or display of a matrix, or manual entry of data, or programs or computers to execute their method.

Slezak et al. shows throughout a program for use with a microtiter plate reader apparatus. Slezak et al. shows display of a matrix of microtiter plate positions with inputted values in Table III. Slezak et al. shows on page 87 that data is entered to the matrix, and may be entered manually in the case of computer failure. Slezak et al. shows that the program can be used for determination of kinetic data by taking time points, in particular in figure 2.

Peden et al. shows throughout a database, programs, and computers for recording laboratory data. Peden et al. also shows computers and program for executing the database. Peden et al. shows that their database employs object oriented programming so that the capabilities of the program may be easily modified in column 2. Among the many features of the program of Peden et al. are use of pull down menus for data entry as shown in column 5 and figure 5.

Mikami et al. shows screening of a panel of cells by cytology for the relation of Bcl-2 expression and tumoregenesis and cancer progression. Mikami et al. manually determine quantitative measures including mitotic index and apoptotic index. Mikami et al. shows results of their measurements in figure 4.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the time course cell assay of Rudolph et al. by use of the plate reader program of Slezak et al. because Slezak et al. shows that their program can be used to determine kinetic data, as depicted in figures 2 and 3 of Rudolph et al. and figure 2 of Slezak. It would have been further obvious to use the database of Peden et al. to record the data of Rudolph et al. because Peden et al. emphasize the flexibility of their program to record a wide range of laboratory data for later use. It would have been further obvious to manually enter data of cells

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that are measured manually to a database so that all data could be compared for each sell sample examined because Mikami et al. shows comparison of manually determined parameters of a cell.

6. Applicant's arguments filed 19 May 2006 have been fully considered but they are not persuasive. The applicants state that the combination of references do not show manual entry of data to a database matrix, however Slezak et al. shows manual entry of data to a matrix of cell data in the event of computer failure, and Mikami et al. (newly applied reference) shows that some parameters of cell analysis are determined manually and therefore it would be obvious to enter the manually determined data manually to a database to compare results of the various assays performed, as shown in Mikami et al. in figure 4. The applicants state that Rudolph does not show the limitation in claim 21 and other claim limitations of rules that determine whether a characteristic of a sample is to be data collected. However, Rudolph et al. shows a protocol of data acquisition in which particular samples are measured at predetermined times for predetermined properties. Rudolph et al. therefore comprises and executes rules of data acquisition which meet the limitations of the claims.

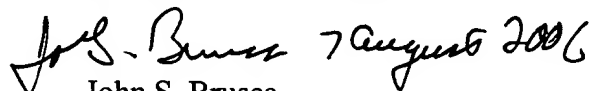
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 7 August 2006
John S. Brusca
Primary Examiner
Art Unit 1631

jsb